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09/818,792	03/27/2001	Ronald P. Sansone	F-183	9874

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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3629

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/818,792
Filing Date: March 27, 2001
Appellant(s): SANSONE ET AL.

MAILED

MAR 10 2005

GROUP 3600

Sansone et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 10, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

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1 Claims 1-3, 11, 12, 13, 17-19, 21, 25 and 28-35 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US 2002/0095306 A1 or US 2002/0042808 A1) in view of Higgins et al. (US 5,754,671).

W.R.T. Claim 1:

Smith et al. discloses a method that enables a recipient to inform a carrier to deliver a mail in a plurality of manners, comprising the steps of:

depositing by a sender with the carrier mail containing the recipient's name and address and a sender's name and address (see Figs. 5-9 for the incoming mails and paragraphs [0022-0023] in 2002/0042808; or Figs. 3-6 and paragraphs [0023]-0038] in 2002/0095306);

capturing by the carrier the name and address of the recipient and the sender in the form an image (see Figs. 5-8, 11 and paragraph [0018]-[0022], [0032] in 2002/0042808; or see Supra Figs. and paragraphs in 2002/0095306);

transmitting the image to a data center;

translating the name and address of the recipient into an e-mail address (see paragraph [0015] with respect to e-mail service in 2002/0042808);

notifying by the data center to the recipient of the expected delivery of the mail (see paragraphs [0014], [0017]-[0023] in 2002/0042808);

notifying the data center of the manner in which the recipient wants the mail delivered (paragraphs [0022]-[0024] in 2002/0042808; or [0037], [0048]-[0053] in 2002/0095306) and

delivering by the carrier mail to the recipient.

However, Smith et al. does not specifically disclose the method including: transmitting the image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumeric; and indicating the selected alphanumeric of the translated image.

Higgins et al. is cited to show that the invention captures mail pieces in the form an image and translates the captured image into alphanumeric (for example, see Fig. 5 for the translation process; see Figs. 18-24, and col. 8, line 65 – col. 9, line 9; col. 11, lines 24-29).

Since both Higgins et al. and Smith et al. are both from the same field of endeavor of automatic mail processing, the purpose disclosed by Higgins et al. would have been well recognized in the pertinent art of Smith et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to replace the mail piece scanning process (which could take much memory storage due to each image's large file size) with the simple process that transmits the captured image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumeric; and indicates the selected alphanumeric of the translated image, as taught by Higgins et al., for the purpose of providing the mail stream with improvement

cursive word recognition (col. 1, lines 47-52) and enhancement of searching speed (which is strongly dependent on the size of the lexicon used; less bits, i.e. smaller size, are required for the alphanumeric than the image file of Smith et al. {see Fig . 6 in Supra 2002/0095306}) which are operates with sufficient throughput to allow it to be part of existing US Postal Service address recognition system (col. 1, lines 53-56 in Higgins et al.).

W.R.T. Claim 2: The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to deliver the mail to a specified name and address (Supra paragraphs [0015]-[0025]).

W.R.T. Claim 3: The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to return the mail to the sender (see Id.).

W.R.T. Claim 11: The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to deliver the mail to the recipient at a different address (paragraph [0024]-[0025] in 2002/0042808);

W.R.T. Claims 12-13: The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to deliver the mail to the recipient by a slower or faster delivery than normal one (see paragraphs [0015]-[0023] in 2002/0042808);

W.R.T. Claims 17-18: The modified Smith et al. further discloses the method including: informing the sender of the delivery of the mail; and wherein the recipient notifies the carrier to hold the mail (see Id.);

W.R.T. Claim 19: The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to destroy (or trash in Smith et al.) the mail (paragraph [0022] in 2002/0042808);

W.R.T. Claim 21: The modified Smith et al. further discloses the method wherein the recipient is notified by e-mail of the availability of the deposited mail (see Id.);

W.R.T. Claim 25: The modified Smith et al. further discloses the method wherein the carrier is notified via e-mail (see Id.);

W.R.T. Claim 28: The modified Smith et al. further discloses the method wherein the recipient notifies a data center as to notify the carrier (see Supra paragraphs regarding notification);

W.R.T. Claims 29-33: The modified Smith et al. further must include the mail containing a stamp, a postal indicia, permit and symbology (see Fig. 6 in 2002/0042808 for example); and

W.R.T. Claims 34-35: The modified Smith et al. further discloses the method wherein the graphic is captured and translated and stored (see paragraph [0015] in 2002/0042808, view "image").

2 Claims 4-10, 14-16, 20, 22-24 and 26-27 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US 2002/0095306 A1 or US 2002/0042808 A1) in view of Higgins et al. (US 5,754,671)

As for Claims 4-10, 14-16, 20, 22-24 and 26-27, the modified Smith et al. discloses the method as cited above and further discloses the method including:

informing the carrier to e-mail the contents of the mail piece to the recipient (see [0014], [0017]-[0023] in 2002/0042808; or paragraphs [0037]-[0038] in 2002/0095306);

mailing by e-mail the contents of mail piece (see Id.);

informing the carrier to e-mail the contents of the mail piece to one or more specified e-mail addresses (see Id.); and

mailing by e-mail to the specified e-mail address (paragraphs [0015]-[0023], [0033] in 2002/0042808).

However, the modified Smith et al. does not specifically disclose the method including the limitations in Claims 4-10, 14-16, 20, 22-24 and 26-27 ("opening the mail", "sending the information contents to PDA", "using facsimile", "how to charge", "recycling the mail", "telephoning", or "notifying via television").

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to arrange to open the mail, sending the information contents to PDA, notify via a facsimile, telephone or television, charge the recipient for the service and recycle the mail because Applicant has not disclosed that the above claimed limitations provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified method of Smith et al. because one of ordinary skill in the art may utilize any type of notification methods and to incorporate

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those methods into the modified notification system of Smith et al.. (see paragraph [0031] in 2002/0042808).

Therefore, it would have been obvious to one having ordinary skill in the art to further modify the method of Smith et al. and Higgins et al. to arrange to open the mail for the purpose of scanning the contents of the mail piece (see Fig. 7 in 2002/0042808); send the information contents to PDA, notify via a facsimile, telephone or television for the purpose of notifying the recipient with the mail information; and charge the recipient for the service and recycle the mail.

(10) Response to Argument

-- In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The test of obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to appellant's argument that Smith et al. requires that the user print personal ID code and the ID code is captured by the post; and this same ID code be associated to any other postal data object, it is noted that the features upon which appellant asserts are not recited in the rejected claim(s) and the modified method of

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Smith et al. does include the essential method steps of capturing; transmitting; translating; and notifying to enable a recipient to inform a carrier of the manner in which the recipient wants some or all of their mail. Furthermore, the appellant never expressly claim a particular approach (e.g. using the user ID or not requiring the ID) to capture the mail piece to patentably distinguish from the prior art. Accordingly, the difference between the appellant's invention and Smith et al. would be obvious.

-- In response to the appellant's argument that the examiner has not cited any art to indicate why it would be obvious to send the contents of the mail piece via different specified channels in the environment of claim 1, 2002/0042808 discloses that communications between users of the system and the hardware components may use any form of electronic communication, such as direct wire, wireless, modems and the Internet (see paragraph [0031]), and therefore, it would have been obvious to utilize any type of electronic communication, such as TV, PDA or any other manners as claimed by the appellant.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Richard Woo

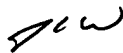
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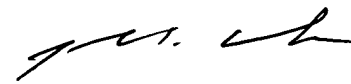
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